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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,972	01/16/2004	James Stoffer	423.027US1	6512
7590 12/31/2008 Schwegman, Lundberg, Woessner & Kluth, P.A. P.O. Box 2938 Minneapolis, MN 55402				
EXAMINER RONESL VICKY M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,972

Applicant(s)

STOFFER ET AL.

Examiner

VICKEY RONESI

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 23-29, 154-159, 162 and 163 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/24/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-8,10-31,35,39-59,61,62,67-70,121,122,132,133,139,141,143-145,147-151,154-168,184,186,187 and 191.

Continuation of Disposition of Claims: Claims rejected are 1-8,10-22,30,31,35,39-59,61,62,67-70,121,122,132,133,139,141,143-145,147-151,160,161,164-168,184,186,187 and 191.

DETAILED ACTION

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 9/24/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

4. Claims 1-8, 10-20, 30, 31, 56-59, 61, 62, 67-69, 139, 141, 143-145, 147-150, 164-168, and 184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780).

The discussion with respect to Shoji et al in paragraph 11 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "capable of curing by air drying," Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Oakes (US 4,370,256).

The discussion with respect to Shoji et al and Oakes in paragraph 12 of Office action mailed 10/19/2006 and is incorporated here by reference.

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

6. Claims 35, 39-52, 54, 55, 70, 121, 122, 132, 133, 151, 160, 161, 186, and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368).

The discussion with respect to Shoji et al and Reuter et al in paragraph 9 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

7. Claims 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368) and further in view of Tucker (US 3,837,894).

The discussion with respect to Shoji et al, Reuter et al, and Tucker in paragraph 10 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is “capable of curing by air drying,” Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

8. Claims 191 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780) in view of Reuter et al (US 2003/0082368) and further in view of Koefod (US 5,531,931).

The discussion with respect to Shoji et al, Reuter et al, and Koefod in paragraph 11 of Office action mailed 8/14/2007 and is incorporated here by reference.

With respect to the newly added limitation that the composition is "capable of curing by air drying," Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group.

Double Patenting

Two (2) obviousness-type double patenting rejections are set forth below.

9. Applicant's statement on page 16 of the amendment filed 9/24/2008 regarding the provisional obviousness-type double patenting rejections is acknowledged. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, I

10. Claims 1-7, 15, 17, 35, 42-45, 70, and 151 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-41 of copending Application No. 10/758,973 (published as US 2004/0186201).

The rejection is adequately set forth in paragraph 13 of Office action mailed on 6/9/2008 and is incorporated here by reference.

Double Patenting, II

11. Claims 1, 13, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of copending Application No. 11/036,416 (published as US 2006/0063872).

The rejection is adequately set forth in paragraph 15 of Office action mailed on 6/9/2008 and is incorporated here by reference.

12. Claims 1, 13, and 14 are directed to an invention not patentably distinct from claim 13 of commonly assigned copending Application No. 11/036,416 (published as US 2006/0063872).

The discussion in paragraph 16 of Office action mailed on 6/9/2008 is incorporated here by reference.

Response to Arguments

13. Applicant's arguments filed 9/24/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Shoji et al fails to disclose a composition that is capable of curing by air drying; (B) that there is evidence that this present invention fills a long felt need in the field; and (C) that there is evidence of commercial success of a product covered by present invention.

With respect to argument (A), Shoji et al teaches the use of epoxy which is curable by air drying given the self-crosslinking and highly reactive nature of its functional group. Applicant has cited col. 11, lines 19-33 of Shoji et al which discloses heating to surface treat to establish that Shoji et al fails to teach a composition that capable of curing by air drying, however, the examiner has cited another aspect of Shoji et al's invention ("third aspect" starting on col. 12, line 21) which is not associated with col. 11, lines 19-33. Therefore, Shoji et al teaches a composition that is capable of curing by air drying.

With respect to argument (B), the declarations of Richard Albers and Charles J. Ray, each filed on 9/24/2008, have been fully considered; however, they are insufficient to establish that the present invention fills a long-felt but unsolved need because the product used in the declaration is not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the declaration only refers to a corrosion inhibiting coating composition that contains binder, 4.7-13 wt % praseodymium oxide, and 36.2-55.6 wt % calcium sulfate--wherein the type of organic binder is not disclosed. The instant independent claims are much broader in scope and include embodiments that are not represented in the declarations. Furthermore, the primers of the declarations are only used with metal substrates and cannot serve to establish a long-felt but unsolved need for a composition used on all types of substrates.

With respect to argument (C), the declaration of Charles J. Ray filed on 9/24/2008 has been fully considered, however, it is insufficient to establish that the present invention is commercially successful given that the data is not reasonably commensurate in scope with the

scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the declaration only refers to a corrosion inhibiting coating composition that contains binder, 4.7-13 wt % praseodymium oxide, and 36.2-55.6 wt % calcium sulfate--wherein the type of organic binder is not disclosed. The instant independent claims are much broader in scope and include embodiments that are not represented in the declaration. Furthermore, the primers of the declarations are only used with metal substrates and cannot serve to establish a commercial success for a composition used on all types of substrates.

Furthermore, there is a lack of evidence regarding the market share. A statement that "Deft" is "effectively 100% of the current marketshare for new F-35 and F-22 Aircraft, and 100% of the marketshare for future F-15 Aircraft" is not a substitute for factual evidence.

Conclusion

14. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/23/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796